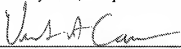


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant:	Di Serio	Confirmation No.:	9212
Serial No.:	10/035,018	Group Art Unit:	3725
Filed:	December 27, 2001	Examiner:	Dimitry Suhol
Title:	METHOD FOR MANUFACTURING MOLDED THEN FORGED PARTS COMPRISING ONE OR MORE RECESSES AND THE IMPLEMENTATION INSTALLATION THEREOF		

CERTIFICATE OF ELECTRONIC TRANSMISSION

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Virginia 22313-1450, Attn: Examiner Dimitry Suhol, Group Art Unit 3725, on
September 20, 2007.*



Victor A. Cardona
Attorney for Appellant
Registration No. 44,589

Date of Signature: September 20, 2007

To: Mail Stop Appeal Brief – Patents
Commissioner of Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

**REPLY TO EXAMINER'S ANSWER BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES**

Dear Sir:

This is reply under 37 C.F.R. § 1.193 from an Examiner's Answer dated July 20, 2007, and a second Answer dated September 13, 2007. Therefore, this reply brief is timely filed within two months on September 20, 2007.

ARGUMENT

This paper relates to the grounds of rejection section of the Examiner's Answer, dated September 13, 2007, and the Response to Arguments section of the same document. The arguments presented in the Appeal Brief are not reiterated herein, but instead are incorporated by reference. Further, specific points newly raised in the Examiner's Answer are addressed below.

Grounds Of Rejection

§ 103 Rejections:

Claims 1 and 3 continue to be rejected as being unpatentable under 35 U.S.C. 103(a) over Mikito in view of admitted prior art and Hiroshi.

On page 4 of the Answer, it is alleged that it would have been obvious to maintain the shape of cavities of a molded preform in the forging of Mikito because whether the shape of the preformed cavities are re-formed or maintained is considered to be an obvious exercise of mechanical design. The appellant respectfully disagrees with this characterization. In particular, Mikito explicitly discloses formation of cavities 51 and 52 in a first step followed by a second step in which a die compresses a preform product to force the material thereof to conform to the shape of the interior of the die and thereby cause flow around extending portions 63 and 64. There would be no reason to change the method disclosed in Mikito to utilize cavities of the same size and shape during the casting and forging processes and in fact the method clearly teaches away from maintaining cavities in a same shape. Instead, the Answer attempts to envision changes to the Mikito method and device to conform it to the claims of the present application, which is mere hindsight reasoning in view of the features of claim 1 and which is improper.

Response To Arguments Section Of Answer

On page 5 of the Answer, it is alleged that rods 63, 64 in Mikito substantially maintain the shape of the cavities. Appellant respectfully disagrees with this characterization since the

cavities in the preform clearly change in size and shape as a result of the forging process resulting in the product depicted in FIG. 9.

Also, the Answer in the second paragraph of page 6 argues that Hiroshi is merely relied upon to teach the use of inserts in a heading/forging step and appears to minimize Appellant's arguments that Hiroshi fails to address a multi-directional rod being inserted in a cavity by a control means prior to a heading operation. As indicated in the Appeal Brief, Appellant notes that there would be no reason for one of ordinary skill in the art in viewing the Hiroshi system and method to seek to remove inserts after molding and prior to forging, because such inserts remain in the cavity in Hiroshi during the forging process. Thus, there would be no reason to combine Mikito and Hiroshi since Mikito utilizes a die to move metal around inserts extending into a cavity such that the preform material may conform to the shape of the inserts while in Hiroshi, rods remain in a core during a casting and forging process without the movement of such preform material being promoted.

On the top of page 7, the Answer addresses Appellant's arguments relative to the combination of Hiroshi and Mikito by arguing that the shape of inserts 63 and 64 in Mikito may be maintained due to the teaching in Hiroshi. Appellant respectfully points out that the maintaining the shape of such cavities goes expressly against the teaching of Mikito in which the change in shape of such cavities is expressly taught and desired.

On page 8 of the Answer the Examiner states that obviousness can only be established by combining or modifying the teachings of the prior art to produce a claimed invention where there is some teaching, suggestion or motivation to do so found in the references themselves or in knowledge generally available to one of ordinary skill in the art. Although both Mikito and Hiroshi deal with casting and forging, including the treatment of cavities during such forging, the methods disclosed are entirely different and would not be applicable to one another. A cavity in Mikito is formed in a first step and in a second step the cavity is modified by the force provided by a die, while in Hiroshi a core is arranged in a cavity during casting which stays therein during a forging operation. There would be no reason to maintain the cavity in Mikito since the movement of the material in the second die, which causes the formation of the desired final

product, teaches explicitly against the maintaining of a cavity in a substantially same shape and size. In contrast, there is no member extended into and out of a cavity taught in Hiroshi, which instead utilizes a core during both a casting and forging process. Thus, the references teach away from one another and the attempted combination by the Examiner is mere hindsight in view of the features of claim 1.

On the bottom of page 8, the Examiner states that claim 2 is a product claim and therefore the features of parent claim 1 cannot patentably distinguish such a claim. The Examiner has not previously raised an objection to the form of claim 1, and Appellant respectfully disagrees that the form thereof relative to claim 2 should preclude patentability when all the relevant features are recited in claim 1.

CONCLUSION

In conclusion, Appellant submits that the proposed combination of Mikito and Hiroshi cannot make claims 1 and 3 of the present application obvious. It is respectfully submitted that there is no teaching of a suggestion or motivation that would cause one skilled in the art to combine these references. As indicated, the cited references teach away from such a combination and even if the references were combined as alleged, they would not result in the subject matter of the claims of the present application. Accordingly, it is respectfully submitted that the proposed combination cannot make the claims of the present application obvious. Further, as all the features of 2 and 4 are not identically disclosed by Mikito, these claims cannot be anticipated by this reference. Thus, Appellant submits that the Final Office Action should be reversed in all respects.

Respectfully submitted,



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Dated: September 20, 2007

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